

2 incorporating Claims 3-5, a divisional application filed upon species 3 incorporating Claim 6, and a divisional application filed upon species 4 incorporating Claim 7. Such election, the corrections indicated and the amendments avoid the rejections raised by the Examiner and do not add any new matter to the invention being claimed, thus making such Claims conform to the arguments of the Examiner and place the remaining Claims in proper form for issuance.

The rejection to Claim 1 as specified in the Office Action are noted. Applicant respectfully disagrees with the Examiner and states that clear distinction lies between the cited prior art and the current invention, and the prior art does not anticipate the current invention.

To begin with, the cited reference on which the rejection is based is a design patent to Ruscitto '381. The Courts have held on numerous occasions the following standard of review regarding anticipation based upon prior art references.

A prior printed publication, to defeat a patent, must describe the invention is such full, clear and exact terms as to enable any person skilled in the art to which it relates to practice the invention.

Seymour v. Osborne, 78 US 516 (1871); *Choat v. Rome Industries, Inc.* 450 F2d 1164, (1971, CA3 NJ). An anticipated reference must describe the patented subject matter with sufficient clarity and detail to establish that the subject matter existed and that its existence was recognized by person of ordinary skill in the field. *ADT Corp. v. Lydall Inc.* (1998, CA FC) 159 F3d 534, USPQ2d 1321.

"In order for a publication to anticipate an invention as defined in a patent claim under 35 USCS §102(b), the publication must disclose all the elements of the claimed combination, or their equivalents, functioning in substantially the same way to produce substantially the same results," held the court in *Codex Corp. v Milgo Electronic Corp.*, (1983, CA 1 Mass) 717F.2d 622, cert. den. 104 S Ct 1719.

Under the above referenced case precedent, the Examiner has had to extrapolate the named and disclosed essential elements of the Ruscitto patent based upon the current application nomenclature and has had to gain its description from one source and one source only - the application upon which it is being used to serve as a basis for rejection. The prior art patent, under 35 USC §102 must be of such full, clear and exact terms as to enable one skilled in the art to practice the patented improvement without the exercise of inventive skill of his own **and without assistance from the patent claimed to have been anticipated.** *Wisconsin Alumni Research Foundation v George A Breon & Co., 85 F2d 166 (1936, CA8 Mo); Preemption Devices, Inc. v Minnesota Mining & Mfg. Co. (1984, CA FC) 732 F2d 903.*

Essential elements cannot be read into the description, nor can information which it does not give. *Baldwin-Southwark Corp. v Coe, 76 App DC 412 (1942); Leow Filter Co. v German-American Filter Co. 164 F 855 (1908, CA Ohio).* The prior description must disclose clearly, truly and full what the subsequent patentee invented and accomplished. *Seabury v Am Ende, 152 US 561, 14 S Ct 683 (1894).* Published descriptions leading up to but not fully accomplishing the desired end of the invention have been held not to anticipate. *Re Cole, 18 CCPA 880, 46 F2d 575, 8 USPQ 260 (1931).* Finally, a prior art patent is considered as part of the prior art only as to what is discloses on its face, unaided by extrinsic evidence, except where necessary to elucidate and make clear what is disclosed. *Davis-Bournonville Co. v Alexander Milburn Co., 1f2d 227 (1924, CA2 NY) revd. on other grounds 270 US 390, 46 S Ct 324.*

In the prior art patent cited, there is no disclosure as to any relationship in size or shape to the manner in which the Ruscitto device maintains an optical disk, and absolutely no reference that Ruscitto is adapted to hold a stack of CDs, and especially no reference to the Ruscitto device "adapted to hold said stack of CDs through respective central holes in said stack of CDs and a lower

flange adapted to be slightly larger than said central holes of said stack of CDs, adapted to support supporting said stack of CDs at an angle”, as indicated in Claim 1 of the present invention. Ruscitto does not portray the manner in which it retain “an optic media disk in any of its FIGS. 1-4.

There must be a suggestion or teaching that the claimed novel form of the prior art could or should be used. See, In Re Cofer, 354 F. 2d 664, 148 U.S.P.Q. 268 (C.C.P.A. 1966). There must be a “reasonable expectation of success” specified in the prior art usage in the current art. Fritsch v. Lin, 21 U.S.P.Q.2d 1739 (B.P.A.I. 1991). If one applies imagination or speculation, one might be able to lean an optical disk against the Ruscitto device or stack several in a circle upon the lower flange resting a side against the central stem. However, that requires speculation. In addition, the Ruscitto lower flange might be fitted within the central hole of the optic media disk, with the base providing the larger portion to hold the CD above the surface upon which the device rests, but certainly not at an angle. If a disk is inserted on the Ruscitto device, it should lay flat, not at an angle, if it were to serve the extrapolated purpose represented by the Examiner.

It is fundamental that claims are to be construed in the light of the specification and both are to be read with a view to ascertain the invention. *Transitron Electronic Corp. v. Hughes Aircraft Co.*, 487 F. Supp. 855, 205 USPQ 799 (1980, DC Mass.). As to the particular vernacular of Claim 1 of the invention, the phraseology employed in the claims is the “guiding star” in the construction of the patent. *Super Products Corp. v. D P Way Corp.*, 546 F2d. 748, 756, 192 USPQ 417, 423-424 (1976, CA7 Wis.). There is no guiding star to the Ruscitto device, except in its pictures, and certainly none indicating a “stack of CDs” or an “angle”. There is nothing wrong in defining something by what it does rather than by what it is. *ReEcherd*, 471 F2d. 632, 176 USPQ 321 (1973, CCPA); *Re Swinehart*, 439 F2d. 210, 169 USPQ 226 (1971, CCPA); *Re Fuetterer*, 319 F2d. 259, 138 USPQ 217 91963, CCPA). Claim 1 states the stack of CDS are supported at an angle. Ruscitto says nothing.

Without the patent language of the current patent, it would not be possible to construe or to reference the features of the

"Prior structures which by modification might be made to perform functions of a later patented device are not anticipations where not designed, adapted to nor used for such functions, and prior art patents cannot be modified or reconstructed in the light of the subsequent invention to build up an anticipation." *Payne Furnace and Supply Co. v Sheridan*, 71 F2d 935 (1934, CA 1 Mass).

Ruscitto does not disclose the current invention "on their face", nor may one soundly state that the Ruscitto anticipates the current invention. The disclosure of a prior art patent, to constitute a valid anticipation, must be clear. Vague, indefinite or ambiguous disclosures do not anticipate. *Mobil Oil Corp. v W. R. Grace & Co.*, 367 F Supp 207, 180 USPQ 418 (1973, DC Conn.) ; See also, *Idacon, Inc. v Central Forest Products, Inc.* (1986, ED Okla) 3 USPQ2d 1079.

Rejection of the current patent based upon Ruscitto is improper, due to the prior art patent not including the essential elements of the current invention. Withdrawal of such rejection is respectfully requested based on the cited argument and authority cited herein.

As to Claim 2, the Examiner cited Ruscitto in view of James, Jr. '942. To support this rejection under 35 USC 103(a), the Examiner's rejection must abide by the following section of the MPEP.

"To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claim combination and the reasonable expectation of its success must both be found in the prior art, and not based on the applicant's disclosure." MPEP § 2142.

The James patent discloses a display rack to hold objects which are disks or disk-like in shape. The implication of James is provided to indicate that the device could be cast (Column 2, lines 63-67, but a further reading demonstrates that reference to be portrayed more so for element 1, FIGS. 1-3, which is the elongated "horizontal" structure member, which is distinctly different than the present invention. Disks in the James patent have an edge inserted within a linear groove 6, with an embodiment having a dove-tail cross-section 26. Disks are not stacked, they are placed within the groove on their edges. They are in no way integrated with the central hole of the disk. They do indicate some form of angular display, but not in any way portrayed in the present invention or disclosed in Claim 2 of the present invention.

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *In Re Geiger*, 815 F.2d 686, 2 U.S.P.Q. 2d 1276 (C.A.F.C. 1987); *In Re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596 (C.A.F.C. 1988). Both the suggestion to make the claimed composition or device or carry out the claimed process and the reasonable expectation of success must be founded in the prior art. *In Re Vaeck*, 947 F.2d 488, 20 U.S.P.Q. 2d 1438 (C.A.F.C. 1991).

The art upon which the rejections are based do not fulfill this requirement and are clearly distinguishable. As indicated, Claim 2 requires a weighted base (absent from James and absent by disclosure in Ruscitto), at least one elongated neck, (absent again from James and Ruscitto) and "at least one flanged CD support peg, said base, neck and flanged CD support peg cast as an integrated singular CD stand with the base substantially larger than the neck, said flanged CD support peg having a smooth tapered central stem adapted to hold said stack of CDS through respective central holes in said stack of CDS and a lower flange slightly larger than said central holes of said stack of CDS, supporting said stack of CDS at an angle of thirty degrees," which are reference in James as

held “in a vertical position and at the various angles in which the object may be displayed than is provided by a rectangularly shaped groove”, (Column 5, lines 12 - 14).

If James would have had pegs which displayed the disks by holding them through a central stem at an angle instead of a groove, the combination of James and Ruscitto might be an appropriate combination. Other than the reference to CDs or optic disk mediums, the two patents bear no natural or obvious combination. Prior art references must either be in the field of Applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the Applicant was concerned, in order to be relied upon as a basis for the rejection of the claimed invention. *In re Oetiker*, 997 F.2d 1443, 24 USPQ2d 1443 (Fed.Cir. 1992). “Obvious to try” is not a valid test of patentability, and in the present case, it would not be obvious to try combining Ruscitto with James to accomplish the task or method disclosed in the current invention. See, *In Re Mercier*, 515 F.2d 1161, 185 U.S.P.Q. 774 (C.C.P.A. 1975). There must be a suggestion or teaching that the claimed novel form of the prior art could or should be used. See, *In Re Cofer*, 354 F. 2d 664, 148 U.S.P.Q. 268 (C.C.P.A. 1966).

There must be a “reasonable expectation of success” specified in the prior art usage in the current art. *Fritsch v. Lin*, 21 U.S.P.Q.2d 1739 (B.P.A.I. 1991). If one attached the Ruscitto patent to the outer surface 2 of James, one might get some borne semblance of the present invention, but it would not serve the simple function or purpose of the present invention, and there is no indication it could be used to serve the same simple and compact storage of a stack of CDS as does the present invention. It would be quite impractical to have a single disk on each peg of the Ruscitto patent attached to the James patent. References cannot be combined arbitrarily and there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USOQ 607 (CCPA 1975). The test for combining

references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin* 170 USPQ 209 (CCPA 1971).

In addition, the groove in the James patent is limited by its own terms, claiming the groove to be only "somewhat greater than the thickness of a compact disk case" (Column 4, lines 38-47), leading one away from the purpose of the present invention, which allows for a stack of CDs to be held as a stack, not as one singular displayed item, as does James.

It is fundamental that claims are to be construed in the light of the specification and both are to be read with a view to ascertain the invention. *Transitron Electronic Corp. v. Hughes Aircraft Co.*, 487 F. Supp. 855, 205 USPQ 799 (1980, DC Mass.). As to the particular vernacular of Claim 1 of the invention, the phraseology employed in the claims is the "guiding star" in the construction of the patent. *Super Products Corp. v. D P Way Corp.*, 546 F2d 748, 756, 192 USPQ 417, 423-424 (1976, CA7 Wis.). Claim 2 identifies a stack of CDs to be held on a common central peg. Neither James nor Ruscitto contain this vernacular and precise description of the function of their inventions. There is nothing wrong in defining something by what it does rather than by what it is. *Re Echerd*, 471 F2d 632, 176 USPQ 321 (1973, CCPA); *Re Swinehart*, 439 F2d 210, 169 USPQ 226 (1971, CCPA); *Re Fuetterer*, 319 F2d 259, 138 USPQ 217 91963, CCPA).

The combination of James and Ruscitto do not form a legitimate basis for the rejection of Claim 2, in this instance, and therefore the rejection based upon 35 USC 103(a) should be withdrawn.

The above amendments to Claims add no new matter to the invention and are made to be place in conformity with the 35 USC 112 rejections of the Examiner in the Office Action. Such amendments should thus place the amended claims in proper form for allowance and overcome the rejections of the Examiner.

CONCLUSION

The applicant submits that the above-noted amendments and remarks put the application in condition for allowance. Claims 3-7 have been withdrawn per the election, although to be included in other divisional applications filed by Applicant, filed under 37 CFR 1.53. Claims 1-2 have been rewritten and the amendments made as noted, and factual and legal argument advanced by Examiner indicating the propriety of withdrawal of the rejections made by the Examiner.

Applicant therefore respectfully requests that the Examiner withdraw the outstanding objections and rejections contained in the Office Action of 10/15/2004, and pass this application to issue. Applicants express their appreciation to the Examiner for Examiners attention and courtesy.

Respectfully submitted;



Randal D. Homburg
Registration No. 41,847
P.O. Box 10470
Midwest City, OK 73140-1470
Phone: (405) 769-9281
FAX: (405) 769-9288
E-mail: rhomburg@cox.net



Certificate of Mailing

This is to certify that on the ~~13th~~ day of December, 2004, the attached and foregoing documents with an appropriate fee, if any, were mailed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 , postage pre-paid, through the United States mails.


Randal D. Homburg